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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,340	08/31/2006	Kai Rossen	7601/88254	9531
66991 7590 05/13/2009 LAW OFFICE OF MICHAEL A. SANZO, LLC 15400 CALHOUN DR. SUITE 125 ROCKVILLE, MD 20855				
EXAMINER LOEWEE, SUN JAE Y				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
05/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/591,340

**Applicant(s)**

ROSSEN ET AL.

**Examiner**

SUN JAE Y. LOEWE

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date 2-13-2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 5-24 are pending in the instant application.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2009 has been entered.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on February 13, 2009 was in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS was considered. A signed copy of form 1449 is enclosed herewith.

***Response to Arguments***

4. The remarks filed on February 13, 2009 have been fully considered, however, they are not found to be persuasive. Below are responses to Applicant's remarks.

“ In response, Applicants submit that the present claims do not merely require combining ingredients but rather performing a reaction step, inducing precipitation, that is essential to stabilizing the product made. This may be contrasted with the Dormoy, Carlsen and Narukawa references where stabilization is apparently achieved by separating reaction components in a two phase system and with the Riley reference where it is not clear that any steps were taken to stabilize products at all. Inducing precipitation, e.g., by adding seed crystals, is not something that is done or suggested in any cited reference and clearly involves more than just changing the order that ingredients are added to a mixture.

....  
In the absence of evidence to the contrary, there would be no reason for one carrying out the process of Riley to adopt a two phase reaction system (e.g., the system of Dormoy, Carlsen or Narukawa) or to precipitate the reaction product concurrently with the addition of reactant. Similarly, there would be no incentive for one carrying out the process of Dormoy, Carlsen or Narukawa to produce ketoprofen in the one phase systems described in Riley since the stabilization of the reaction product would be lost. ”

The difference between the prior art and the instant claims is the following (as noted in the office action dated April 21, 2008):

*Ascertaining the differences between prior art and instant claims.*

The differences between the teaching of Dormoy et al. and the instant claims:

- a) The oxidation is carried out in biphasic medium in the prior art; the instant claims are drawn to a one-phase aqueous medium
- b) The oxidation product is allowed to crystallize out.

For the reasons of record, it is also maintained that the prior art suggests to one of ordinary skill to practice the instant invention with the modifications noted above. See pg. 5 of the office action dated April 21, 2008. Applicant's remarks are noted, however, they are not found to be persuasive. For the reasons provided above, it is maintained that the prior art makes obvious the instant invention. Claims 5-24 remain rejected. Currently, prosecution is limited to the elected species (see office action dated April 21, 2008, pg. 2).

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe/  
5-11-2009